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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/390,824	09/07/99	OBERMAIER	H 10981-1400-1

MM92/0405  
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EXAMINER

FIGUEROA, F

ART UNIT

PAPER NUMBER

2833

DATE MAILED:

04/05/01

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

<b>Office Action Summary</b>	Application No. 09/390,824	Applicant(s) OBERMAIER, HANNSJORG	
	Examiner Felix O. Figueroa	Art Unit 2833	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 16 February 2001.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☒ The proposed drawing correction filed on 12 March 2001 is: a) ☒ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

### Attachment(s)

- |   |  |
|---|--|
| 15) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                  | 18) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 16) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 19) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 17) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 20) <input type="checkbox"/> Other:  |

## **DETAILED ACTION**

### ***Response to Amendment***

The amendment filed 02/16/01 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: In claim 21, a plurality of electrical leads on the card and the chassis.

Applicant is required to cancel the new matter in the reply to this Office Action.

Applicant is reminded that any new claim(s) presented must present arguments pointing out specific distinctions / patentability over the prior art. See 37 CFR 1.111(b).

### ***Specification***

The disclosure is objected to because of the following informalities: it is noted that the specification is replete with errors similar to those mentioned in regard to the claims in the first office action. Example of such are: in page 9 line 24 (chassis' system), page 10 lines 5-7. The specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

### ***Drawings***

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the

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description: 79. It appears that reference numeral "77" in the center of Fig. 1 should be changed to --79--. Correction is required.

### ***Claim Objections***

The claims are objected to because of the following informalities:

In claim 1 line 2, it is suggested that "a system connector" be changed to --a card system connector-- to provide consistency of this limitation along the claim. In line 5, it is suggested that "a system connector" be changed to --a chassis system connector--. See also claim 8 line 2, claim 13 line 2, claim 17 line 2, and claim 20 line 2.

The claims recite "a card-insertion direction" referring to the direction in which the card is inserted, and "a chassis insertion direction" referring to the direction in which the carrier is inserted into the chassis. It is noted, however, that "a chassis insertion direction" should be --a carrier insertion direction-- to provide consistency within the terms used.

In claim 13 line 29, "cards' system connectors" should be changed to --card system connectors--. In line 19, "the chassis...connector" should be --one of the chassis--. In lines 28 and 35, "a chassis...connector" should be --one of the chassis--. In line 32, "a card bulkhead" should be changed to --the card bulkhead--. In line 32 "a chassis opening" should be --one of the chassis openings--.

In claim 20 line 5, "a card" should be --the card--.

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

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The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1, 8, 13, 17 and 20 recite "the card has a lower edge... that defines a card insertion direction". However, a direction can not be defined by just one point (the lower edge/the card system connector), but needs a vector defined by two points.

Claim 4 recites the limitation "the card movement" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Claim 5 recites the limitation "the card movement" in lines 2 and 3. There is insufficient antecedent basis for this limitation in the claim.

Claim 7 and 12 recite the limitation "the Peripheral Component Interconnect Bus standards" in lines 2-3, and 15-16 respectively. There is insufficient antecedent basis for this limitation in the claim.

Claim 21 makes use of alternative language which conflicts with the original language used on the specification making the claim unclear. It is noted, however, that the specification and the drawings, as originally filed, do not provide basis for the plurality of electrical leads, on the card and the chassis. Examples of such conflicting language are: a first plurality of electrical leads referring to the first connector, and a connector referring to the wiring.

### ***Claim Rejections***

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The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-4, 7-9, 17-22 are rejected under 35 U.S.C. 102(b) as being anticipated by Cranston, III et al. (US 5,708,563).

Cranston discloses a carrier (11) comprising a body having a front end (23) and a rear end (21), a first (61) and second (71) system connectors (first and second plurality of leads on claim 21), and first and second guides at the front and rear ends; a card (71) having a lower edge including a card system connector and a bulkhead (73) which is oriented parallel to the card insertion direction; and a chassis (3) including a chassis system connector (not shown), an opening (see Fig. 3), defining a chassis insertion direction (carrier insertion direction of claim 22) which differs from the card insertion direction and a guide (41). Regarding claims 17-19, the method claimed is inherent in the structure of Cranston.

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Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Cranston, III et al. in view of Welsh (US 4,935,847).

Welsh teaches the use of a handle (30) on the front end of the carrier (12) to facilitate the insertion and extraction of the carrier into the chassis (14). It would have been obvious to a person having ordinary skill in the art at the time the invention was made to use a handle on the front end of the carrier, as taught by Welsh, to facilitate the insertion and extraction of the carrier into the chassis.

Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Cranston, III et al.

Cranston discloses the claimed invention except for the adjustable guide. It would have been obvious to one having ordinary skill in the art at the time the invention was made to make one or both of the guides adjustable, since it has been held that the provision of adjustability involves only routine skill in the art. *In re Stevens*, 101 USPQ 284 (CCPA 1954).

Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Cranston, III et al. in view of Clements (US 5,963,681).

Cranston discloses the guide (41) extending from end to end of the chassis. Clements teaches a guide/track (10) of translucent material and a light source (20) to provide information of the system (see col. 4 lines 50-65). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to a guide/track of translucent material and a light source as taught by Clements, to provide information of the system.

Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Cranston, III et al. in view of Beak (US 5,496,185).

Beak teaches the use of a compressive electrically conductive material connecting a card (10) to a chassis (16) to provide ground connection between the card and the chassis. It would have been obvious to a person having ordinary skill in the art at the time the invention was made to use a compressive electrically conductive material connecting a card to a chassis as taught by Beak to provide ground connection between the card and the chassis.

Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Cranston, III et al. in view of Clements and Beak.

See discussion on claims 10 and 11 above.

Claims 13-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cranston, III et al. in view of Clements.

Cranston as modified by Clements discloses the claimed invention except for the plurality of carriers. It would have been obvious to one having ordinary skill in the art at the time the invention was made to include multiple carriers, since it has been held that mere duplication of parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

Claim 16 is rejected under 35 U.S.C. 102(e) as being anticipated by Clements.

Clements discloses a connection system (40) comprising a chassis connector mounted on a backplane defining an insertion direction with the opening, a light source (20) and a subsystem controlling the light source.



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***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Mallory et al. (US 4,694,380) discloses a carrier similar to that of the present invention.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Felix O. Figueroa whose telephone number is (703) 308-0097. The examiner can normally be reached on Mon.-Fri., 8:00-5:00.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1782.

ffr  
April 3, 2001

  
**RENEE LUEBKE**  
**PRIMARY EXAMINER**